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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,954	01/27/2000	Anna Marie Pyle	58077/JPW/JSG	1593

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EXAMINER

GOLDBERG, JEANINE ANNE

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/492,954

Applicant(s)

PYLE ET AL.

Examiner

Jeanine A Goldberg

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 1,2 and 6-8.

Claim(s) withdrawn from consideration: NONE.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


JEANINE A. GOLDBERG
PATENT EXAMINER

Continuation of 2. NOTE: The response has amended Claim 1 to indicate a nanomolar range. The response fails to point to any support in the specification for such a limitation. .

Continuation of 5. does NOT place the application in condition for allowance because: The arguments are all drawn to the newly amended Claims. Therefore the arguments are moot. However, Kowalczykowski, Eggleston, and Bjornson teach using DNA substrate within the claimed range. Kowalczykowski teaches for the fluorometric helicase assay, the DNA substrate was 10uM (0.01 nM). Moreover Bjornson teaches the fluorescence assay is extremely sensitive allowing DNA unwinding reactions to be monitored continuously at DNA concentrations as low as 1nM.

The response asserts that there is no motivation to combine the cited references. This argument has been thoroughly reviewed, but is not found persuasive because Bjornson states the benefits of using a fluorescence assay to monitor helicase unwinding of a nucleic acid for continuous real-time. The response asserts that it is unpredictable that the assay would work for RNA. This argument is not supported by evidence, but rather merely attorney arguments.

With respect to Kowalczykowski and Eggleston, the response asserts that there is no motivation and only obvious to try. This argument has been thoroughly reviewed, but is not found persuasive because Eggleston and Kowalczykowski both specifically states that the assay would be amenable to RNA. .

Continuation of 10. Other: The instant copy of the claims filed does not reflect the status of all the claims that were presented in the case. For example, Claim 3-5 are not indicated to have been cancelled. Therefore, this amendment is considered non-compliant. .


JEANINE A. GOLDBERG
PATENT EXAMINER